

No. 1827.

IN THE
United States
Circuit Court of Appeals
FOR THE NINTH CIRCUIT 1.0

American Disappearing Bed Com-
pany,

Plaintiff in Error,

vs.

Edward Arnaelsteen,

Defendant in Error.

BRIEF FOR DEFENDANT IN ERROR.

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This cause comes before this court upon a writ of error from the Circuit Court of the United States for the Southern District of California, Southern Division.

Plaintiff in error was plaintiff below and defendant in error was defendant below, and we shall for brevity hereinafter refer to said parties as plaintiff and defendant.

A demurrer by defendant was entered against plaintiff's declaration claiming that plaintiff's patent No.

839,996, as alleged in said declaration, was a mere aggregation of unrelated elements, and not patentable;

That it is an illegitimate combination; and

That the claims made in said patent show on their face the lack of patent novelty; and

That they are ambiguous, unintelligible and uncertain.

That after argument by defendant in support of said demurrer and by plaintiff against said demurrer, the court decided "That the patent relates not to an article "of manufacture, but to a species of architecture, and "that a patent on an architectural design or product is "without authority of law," and made an order sustaining the demurrer and dismissing the bill.

POWER TO DISMISS ON DEMURRER.

We believe that it is now well settled that the question of novelty or invention may be raised by demurrer to the bill or declaration; and that in considering this question the court may take judicial notice of facts of common and general knowledge.

One of the recent cases where a bill has been dismissed on demurrer is the case of *Westrumit Co. of America v. Commissioners of Lincoln Park*, 164 Fed. Rep. 989. There the patent was for a process of preventing dust in the streets by sprinkling the street with a mixture of oil and water. The Patent Office had granted five claims on this process. The court held it to be a mere matter of knowledge, and sustained the demurrer, the judge giving as one of the reasons for sustaining the demurrer "the great expense which attends the taking of testimony "in patent cases."

In *Richards v. Chase Elevator Co.*, 158 U. S. 299, the Supreme Court held that it was proper in clear cases to dispose of a patent on demurrer, saying:

“While patent cases are usually disposed of upon bill, answer and proof, there is no objection, if the patent be manifestly invalid upon its face, to the point being raised on demurrer and the case being determined upon the issue so formed.”

In the case of *Fowler v. The City of New York*, 121 Fed. Rep. 747, the Court of Appeals of the Second Circuit sustained the decision of the court below, dismissing a patent on demurrer because simply covering matter of common knowledge.

In *Lyons v. Bishop*, 95 Fed. Rep. 154, a patent for a ladies' hat box was held invalid on demurrer.

In the case of *Lamson Consolidated Service Co. v. Siegel Cooper Co.*, 106 Fed. Rep. 734, a patent for store service apparatus was declared void on demurrer.

In the case of *Conley v. Marum*, 83 Fed. Rep. 309, the patent was not only held void on demurrer, but the court commended this short-cut to a decision. Judge Cox, in rendering the decision, said:

“Indeed, the practice of disposing of this question *in limine* is not only permitted, but encouraged by the courts. *Strom Manf'g Co. v. Weir Frog Co.*, 75 Fed. 279. Patent litigation is so expensive, dilatory and oft-times vexatious, the records frequently containing a mass of irrelevant matter not even alluded to at the argument, that it would seem to be the interest of both parties that the question of patentability should be de-

“terminated before the floodgates of testimony are “opened.”

“Certainly such practice ought to be encouraged. “Otherwise the life of a worthless or invalid patent “might be prolonged and sums exacted by way of com- “promise from users by reason of the dread of the heavy “expenses attending the taking of testimony and other “matters necessary to the preparation of patent suits “for final hearing.”

American Fiber Co. v. Buckskin Fiber Co., 76
Fed. Rep. 825;

Patent Button Co. v. Consolidated Fastener Co.,
84 Fed. Rep. 191;

*Fabric Coloring Co. v. Alexander Smith & Sons’
Carpet Co.*, 109 Fed. Rep. 329;

A. R. Milner, Seating Co. v. Yesbera, 111 Fed.
388.

AGGREGATION IS NOT INVENTION.

This term “aggregation” is applied where two or more old and well-known devices are brought into juxtaposition and each continues to perform its old function without any new result issuing from their united action.

The difference between a patentable combination and an unpatentable aggregation is clearly brought out in a case decided by the Supreme Court. (*Reckendorfer v. Faber*, 10 O. G. 71, C. D. 1876, p. 430.) In this case the point at issue was whether a piece of rubber attached at the end of a lead pencil for the purpose of erasing marks constituted a patentable invention. In its decision the court says:

“A combination to be patentable must produce a different force or effect or result in the combined forces or processes from that given by their parts. There must be a new result produced by their union. If not so, it is only an aggregation of separate elements. An instance and illustration is found in the sewing machine, where one part advances the cloth and another part forms the stitches, the action being simultaneous in carrying on continuous sewing. In the case of a combined lead pencil and eraser, the parts claimed to make a combination are distinct and disconnected. There is not only no new result, but there is no joint operation. The lead and the rubber each performs its separate function as if they were not part of the pencil. It may be more convenient to have the two joined together, but this mere joinder or aggregation is not invention within the patent law.”

Therefore we claim that plaintiff's patent is a mere “aggregation” of separate elements, producing no new result by their union; plaintiff claims that it saves space; it may be more convenient in tenement houses, but it does not save space, for it takes just as much space for a bed when chambered in a room its size as when in a large room for occupancy; if the bed is stored in a recess or a small room, the recess or room cannot be used for anything else; and if the bed be removed from the recess, the recess can be used for storing trunks, boxes, wood, coal or anything that a space that size would hold; so in this combination there is no new result obtained, the bed forming its same old purpose and the small room or recess forming its same old purpose.

LACK OF PATENT NOVELTY.

We claim that neither a building, nor an apartment, nor a room is patentable, and that the claims in plaintiff's patent is purely a matter of architecture. Plaintiff in his brief on page 15 says, "that until Mr. Holmes "blazed the way, such a construction and interrelation "of parts was unknown; that it was not a part of the "known art"; defendant, in January, 1897, at No. 2232 East 8th street, in the city of Los Angeles, California, constructed a building containing this very same disappearing bed idea, that doors closed the opening of the recess, instead of the end boards of the bed; that in 1899, at 124-125 South Olive street, in the city of Los Angeles, state of California, W. C. James constructed a building in which a bed was built adapted to chamber in a recess, the end of the bed closing the mouth of the recess.

The art of a disappearing bed can be recognized in the "trundle-bed," which I venture some of your Honors have slept in; a bed made low that it could be pushed under a higher bed; an opening or recess, large enough to trundle a bed, built in a room, is surely not a subject-matter for a patent; we must admit that a bed as merely a bed is old and not patentable, and that the shape or size of a room is not patentable.

In the specifications of plaintiff's patent, beginning after the period in line 96, he says, "In this connection "it is to be understood that the front of a china closet or "other device built into the wall is regarded as a part "of such wall"; and beginning after the period in line 93 of plaintiff's specification he says, "As the full ceiling

“height of the apartment is not necessary in bath rooms
“and closets, the placing of the bed underneath such
“rooms will not reduce their utility.”

The same thing can be said for any other room in a building; if there is a high ceiling, and Mr. Holmes, or some other man, should discover that the ceiling is higher than necessary, and would suggest putting a floor in the room half way between the main floor and the ceiling, forming two rooms, and thus utilizing space, he would be entitled to a patent?

It is a matter for the owner of a building to decide, how high, or wide, or long, or the shape, of his building, or the rooms therein; and that the height, width, length and shape is purely a matter of architecture, and not patentable.

We are quite sure that “doors,” “floors,” “scaffolds,” “windows,” “beams,” “walls,” and the construction of a building, if they possess the necessary newness, is subject-matter for a patent; but in plaintiff’s patent, the claims therein are merely for a recess in a “building,” an “apartment house,” an “apartment,” or a “room,” large enough to chamber a bed; leaving to the builder the art of enclosing the recess, with wood, iron, cement, or any other material, and in any way or manner he chooses.

Webster’s International Dictionary defines the word recess as

“Part of a room formed by the receding of the wall,
“as an alcove, niche, etc.”

“A bed which stood in a deep recess.”—*W. Irving.* *and*

Thus we see that a recess, as used in plaintiff's patent, is old, and if Mr. Holmes looked up the meaning of the word he was using to describe his alleged new discovery, he would have there seen that a recess was very old, and that it had been used for standing a bed in.

THE PATENT AS AN ARTICLE OF MANUFACTURE.

Claims 1-2-3-4-5-6-7-10 and 11 are for a building; claims 8 and 13 for an apartment house; claim 9 for an apartment; and claim 12 for a room. Defendant insists that none of the above claims are for an article of manufacture; but is a kind of architecture, and not a patentable subject-matter. In plaintiff's specifications he tells of many ways that a room or rooms can be arranged, and variously constructed; just like an architect would show anyone wishing to build, how the rooms could be connected and varied, in size and shape, to suit their idea of convenience, beauty, and the amount of money they were prepared to invest, in building. Nowhere in plaintiff's 80-page brief does he cite an instance where a building, an apartment house, an apartment, or a room, was patented; there are many patents for the way the material or parts of a building may be constructed, but no patents for the plan of a building.

As to what is considered a "manufacture" we cite the written opinion of the Honorable Judge Olin Welborn, as found on pages 29 to 35 of the transcript in this case.

We agree with the Honorable Court's opinion and decision, and using the court's language: